

Applicants hereby elect, with traverse, the following species:

1. Arsenic as contaminant species
2. Ruthenium oxide (RuO_2) as ruthenium species
3. Sand as support material species
4. Water as material purified species.

Support for RuO_2

The specification at page 11, lines 1-2, states that the ruthenium species are RuO_2 having varying degrees of hydration. It is clear from the specification that the ruthenium oxides are not RuO , as stated in the Reply filed September 22, 2005, but are RuO_2 .

This restriction requirement is traversed on multiple grounds. Including that the statutory standard has not been met; the classification system does not support a restriction requirement; applicants have a right to define their invention; there is no serious search burden; applicants have paid for an examination of all claims, and in any case, discretion should be exercised and restriction not required.

The Statutory Restriction Standard Has Not Been Met

The Patent statute states:

"If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." [Emphasis supplied, 35 U.S.C. 121]

The standard requires that the allegedly multiple inventions be "independent and distinct." This standard has not been met.

Classification Does Not Support a Restriction Requirement

The patent statute states:

"the Commissioner may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed." 35 U.S.C. 9

The classification system exists "...for the purpose of ...determining novelty, not to determine whether a claim defines multiple inventions which may or may not be independent and distinct.

Applicant Has a Right to Define the Invention

By requiring restriction, applicants are deprived of their statutory rights under 35 U.S.C. 112 to have "claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention." The Examiner has, in effect, carved out a portion of applicants' invention and rejected it under the guise of a restriction requirement under 35 U.S.C. 121. This the commissioner may not do.

The Search Here Does Not Impose a Serious Burden

MPEP Section 803 **requires** that the examiner examine the application on the merits if the search and examination of an entire application can be made without serious burden, even though it includes claims to independent or distinct invention. The Examiner has made no showing that a search of this number of subclasses is a serious burden, particularly in light of the online searching system in which one can create subclasses by combining subclasses and/or key words. The burden of proof to show "serious burden" is on the Examiner. This burden has not been met.

Applicant Has Paid for Examination of All Claims

Having paid an application fee, applicants are entitled to have the Examiner determine the novelty and non-obviousness of the subject matter claimed. If this requires a search of three or more subclasses, so be it. If the position of the Examiner is accepted, applicants will be burdened with the expense of additional applications. These expenses include government filing fees, issue fees and maintenance fees, in addition to attorneys' fees and the value of the time that the inventor will necessarily spend during prosecution.

Restriction is Discretionary

Even if the statutory standard has been met, discretion should be exercised in this case and restriction not required for the reasons given herein.

Withdrawal of the restriction requirement is respectfully requested.

If the restriction requirement is maintained, it will be clear on the record that the PTO considers the groups to be patentably distinct from one another *i.e.*, *prima facie non-obvious* from one another. This means that a reference identical to the one group would not render the other group *prima facie* obvious.


Appln. No. 10/698,358
Amd. dated September 30, 2005
Reply to Office Action of August 23, 2005

Favorable consideration and examination of all
pending claims on the merits are respectfully requested.

Respectfully submitted,

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